



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,619	08/25/2003	Dennis A. Boismier	1001.1689101	2861
28075	7590	03/17/2008		
CROMPTON, SEAGER & TUFTE, LLC			EXAMINER	
1221 NICOLLET AVENUE			WYSZOMIERSKI, GEORGE P	
SUITE 800				
MINNEAPOLIS, MN 55403-2420			ART UNIT	
			PAPER NUMBER	
			1793	
			MAIL DATE	
			DELIVERY MODE	
			03/17/2008	
			PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/647,619

**Applicant(s)**

BOISMIER ET AL.

**Examiner**

George P. Wyszomierski

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/11/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23 and 28-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-893)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. Initially, the examiner notes that some inconsistency appears to exist regarding which claims were pending at the time of the November 9, 2007 Office Action. Specifically, Applicant states on pages 4 and 6 of the remarks filed January 11, 2008 that claims 25 and 34 were canceled by the amendment of October 24, 2007. However, a review of the file indicates that the listing of claims filed on that date included claims 25 and 34. Further, Applicant asserted in the remarks accompanying the October 24, 2007 amendment that claims 25 and 34 were believed to be patentable; see pages 4 and 6 of those remarks with respect to claim 25, and pages 5 and 6 of those remarks with regard to claim 34.

In any event, Applicant's response of January 1, 2008 presented a new listing of claims, with claims 23 and 28-32 pending, and those claims will be examined herein.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 23 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heath (U.S. patent 5,725,570) in view of Bellouard et al. (U.S. Patent 6,669,794).

Column 8 of Heath discloses a medical device including wire loop portions made of a Ni-Ti alloy that initially has linear elastic properties but includes a flexible portion which has been heated to obtain superelastic properties. Heath does not state that an intermediate portion of the prior art devices is flexible or superelastic, "only one" superelastic region as recited in instant

Art Unit: 1793

claim 29, does not refer to "filter legs" as recited in instant claims 23 and 28, and does not refer to the temperature range of instant claim 31. However,

a) With regard to intermediate portions or only one portion of superelasticity, Bellouard indicates that it was known in the art, at the time of the invention, to subject Ni-Ti alloys for use as medical devices to localized heat treatments to obtain superelasticity in a desired portion of the device. See Bellouard column 7, lines 5-10. Further, Bellouard column 10, lines 35-45 as well as column 13 of that reference indicate that any desired portion or portions of the devices may be made superelastic in this manner.

b) Applicant has not defined the term "filter leg" in any specific manner such that it defines any specific shape, and the examiner's position is that this term as claimed refers merely to some portion of a filter material. The objects disclosed by Heath appear to be useful as part of a filter.

c) The temperature range used in Heath column 8 overlaps that presently claimed.

Thus, the combined disclosure of Heath and Bellouard et al. would have rendered devices as claimed obvious to one of ordinary skill in the art.

4. Claims 23 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni et al. (U.S. Patent 6,375,629) in view of Bellouard et al.

Column 7 of Muni discloses a core wire made of a Ni-Ti alloy that initially has linear elastic properties but includes a flexible portion which has been heated to obtain superelastic properties. Muni does not state that an intermediate portion of the prior art devices is flexible or superelastic, "only one" superelastic region as recited in instant claim 29, does not refer to "filter legs" as recited in instant claims 23 and 28, and does not refer to the temperature range of instant claim 31. However,

a) The disclosure of Bellouard columns 7, 10 and 13 renders the making of any desired portion or portions of the Muni devices superelastic obvious to one skilled in the art, for reasons as stated in item 3(a) supra.

b) Muni column 3, line 19 indicates the suitability of the prior art materials for use in filters. Further, Applicant has not defined the term "filter leg" in any specific manner such that it defines any specific shape, and the examiner's position is that this term as claimed refers merely to some portion of a filter material. The objects disclosed by Muni appear to be useful as part of a filter.

c) The temperature ranges disclosed in column 7 of Muni overlap those as presently claimed.

Thus, the combined disclosures of Muni et al. and Bellouard et al. would have rendered devices as presently claimed obvious to one of ordinary skill in the art.

5. In the remarks filed January 11, 2008 Applicant alleges that the present invention can be distinguished from the prior art in that the "filter leg" limitations of the independent claims as amended and/or the temperature limitations of instant claim 31 would render the claimed invention patentably distinct from the prior art devices. Applicant's arguments have been carefully considered, but are not persuasive of patentability because:

a) With respect to filter legs, it is unclear what particular structural features would be required in order for a device to be considered a "filter leg". The examiner's position is that the prior art devices, given their broadest reasonable structural interpretation, would be useful as a filter leg, within the scope of the instant claims. The examiner further notes that in figure 5 of

the present specification, filter legs **54** are depicted in the form of a bent wire shape, and submits that devices of such a shape would be within the purview of the applied prior art.

b) With regard to temperature, it is initially noted that claim 31 is directed to a product-by-process limitation, and that the burden falls to Applicant to show that the claimed products differ from those of the prior art, regardless of the methods by which they are made.

Nonetheless, claim 31 states that one forms the claimed devices "by heating to a temperature that is at least as high as a final austenitic temperature of a material forming the linear elastic member." Exemplary embodiments of this temperature are disclosed on page 9 of the present specification as being a range of 325-375.deg.C. Heath column 8, line 57 discloses a temperature of 460.deg.C, which is at least as high as this range, and Muni column 7, line 67 discloses a temperature of 350.deg.C, which is in the range utilized in the present specification.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1793

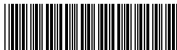
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/George Wyszomierski/  
Primary Examiner  
Art Unit 1793

GPW  
March 3, 2008

**Application Number****Application/Control No.**

10/647,619

**Applicant(s)/Patent under  
Reexamination**

BOISMIER ET AL.

**Examiner**

George P. Wyszomierski

**Art Unit**

1793